

REMARKS

Claims 1-36 are pending in the application.

Claims 1-29 and 36 have been rejected.

Claims 3-5, 12 and 14-36 are objected to.

Claims 1-8, 12, 14, 17, 20, 22, 25, 28, 30, 33, and 36 have been amended.

I. CLAIM OBJECTIONS

The Office Action objects to various informalities in Claims 3-5, 12, and 14-36. The Applicant has amended Claims 3, 12, 14, 20, 22, 28, 30, 33, and 36 to correct the informalities noted in the Office Action. The Applicant respectfully requests withdrawal of the claim objections.

II. REJECTION UNDER 35 U.S.C. § 112

Claims 3-5, 12, and 14-29 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Applicant has amended Claims 3, 12, 14, and 22 to correct the informalities noted in the Office Action. The Applicant respectfully requests withdrawal of the § 112 rejection of Claims 3-5, 12, and 14-29.

III. ALLOWABLE CLAIMS

The Applicant thanks the Examiner for the indication that Claims 14, 22, 30, and 33 would be allowable if rewritten to overcome the claim objections and the § 112 rejection. The Applicant has amended Claims 14, 22, 30, and 33 to overcome the claim objections and the § 112 rejection. As a result, Claims 14, 22, 30, and 33 (and their dependent claims) should be in condition for allowance. The Applicant respectfully requests full allowance of Claims 14-35.

The Applicant also thanks the Examiner for the indication that Claims 2-13 would be allowable if rewritten in independent form. However, because the Applicant believes that Claims 2-13 depend from allowable Claim 1, the Applicant has not rewritten Claims 2-13 in independent form.

IV. REJECTION UNDER 35 U.S.C. § 103

Claims 1-13 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,308,226 by Kainuma (“*Kainuma*”) in view of U.S. Patent No. 5,966,710 by Burrows (“*Burrows*”). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Kainuma recites a system that allows a communication device to move in a network. (*Abstract*). After the communication device moves, the device updates a repository with the new network address of the device. (*Col. 12, Lines 32-41*).

Regarding Claim 1, *Kainuma* simply allows a communication device to update a repository with a new network address. *Kainuma* does not disclose “retrieving” a “list of locally owned address information” from “each of [a plurality of] distributed address databases,” where each address database includes “locally owned address entries” and “remotely owned address entries” as recited in Claim 1. *Kainuma* does not mention that the new network address is “reported” after it is retrieved.

Moreover, the Office Action acknowledges that *Kainuma* fails to teach “sorting the retrieved address information” as recited in Claim 1. The Office Action then asserts that *Burrows* discloses this element of Claim 1. *Burrows* recites a system for locating stored information using an index. (*Abstract*). In order to generate an index, information may be sorted. (*Col. 9, Lines 53-54*). However, *Kainuma* allows a communication device to update a repository with a new network address. There is no explanation in the Office Action as to why a single network address from a communication device needs to be sorted before being stored in a repository. In addition, *Kainuma* contains no mention of generating an index, which is why *Burrows* performs the sort. Because the Office Action fails to identify any actions in *Kainuma* that require the use of a sort, the Office Action fails to establish that one of ordinary skill in the art would be motivated to modify *Kainuma* with the

teachings of *Burrows*. As a result, the Office Action fails to establish a *prima facie* case of obviousness regarding Claim 1.

Regarding Claim 36, *Kainuma* fails to disclose a repository generating a report by retrieving information from the repository's own database and from other databases. As a result, *Kainuma* fails to disclose, teach, or suggest a reporting module operable to retrieve "the locally owned address information from its address database" and "the locally owned address information from each of the other interconnected modules" and to report the information as recited in Claim 36. Further, as noted above, the Office Action acknowledges that *Kainuma* fails to teach sorting the address information, Applicant respectfully believes it is improper to modify *Kainuma* with the teachings of *Burrows*. As a result, Applicant submits that the Office Action fails to establish a *prima facie* case of obviousness regarding Claim 36.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-13 and 36.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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